

Record of the Substance of the Telephone Interview

Participants: Examiner: Sean Vincent, and Supervisory Patent Examiner: Steve Griffin

Applicant: Sheng-Guo Wang

Date: 06-16-2006

I. Applicant expresses his thanks to

- the Examiner and the SPE for their writing one allowable claim for the present invention and their time for the telephone interview; and especially to
- the Honorable Under Secretary of Commerce Jon Dudas and the Honorable Commissioner for Patents John Doll.

II. Claims discussed: 37 – 39, 21 – 22, 24 – 25, and 26.

III. Identification of prior art discussed: The 2-10-2006 O.A. has only rejection on 35 US 112.

Applicant also states the present invention is new, unobvious, useful and patentable over the all prior art, including

Harding (GB) US 4793840; Yoshimura (JP) US 5073179; Urruti (US) US 5551967; Yamamura (JP) US 6220057; Kenmochi (JP) US 6178778; Kohei (JP) JP 06-206734.

IV. Identification of the principal proposed amendments of a substantive nature discussed:

1. New Claims 37 – 39: are based on the Examiner's proposed allowable claim with necessary correction.

- Claim 39: the Examiner's proposed allowable claim with only one necessary correction as:

“while heating and melting said preform, drawing said optical fiber from said preform at a *drawing speed* to change its the geometrical size of said preform to form ~~a bare~~ said optical fiber which is a bare optical fiber before coating”.

It is because the Fiber Drawing Capstans 13 is really drawing said optical fiber from said preform as shown in Figures 1-11 and the Specification, as well as the prior art. Also, please refer to the terms “the preform feeding speed” and “the fiber drawing speed” in the Specification and the claims. Otherwise it would imply “the preform drawing speed”, not “the fiber drawing speed”.

The Examiner says: Ok, that does make some sense, but just thinks as written as the fiber or preform is changing the shape.

Applicant expresses that drawing the fiber from the (heating and melting) preform which is changing the size to form the fiber. It is the fact. It is for correction.

The Examiner agrees with this change. Applicant thanks for that.

- Claim 37, in addition, has two necessary reasonable changes:

(a) locations, such as “measuring a preform outer diameter by a measurement device ~~located immediately above a furnace in~~ before a heating and melting stage”, that is supported by paragraph 0040 ... in the Specification; and (b) deviations

The Examiner recognizes that it is supported by the Specification. His question is: that kind of broaden claim, does find over the prior art, or not? He needs to search what is the prior art. He says that he drafted the allowable claim becoming new claim 39, not only just from the support of the disclosure, but also distinguishes from the prior art.

Applicant points out that no prior art mentions or suggests these. He does not delete any step, but only does minor reasonable corrections/changes. Applicant respectfully requests to consider MPEP 2173.02: “When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.” [emphasis original] Applicant already presented allowable patentable materials. He thinks that the changes are reasonable and should be allowed as the MPEP mentions.

Applicant states that no prior art for that because the prior art is no preform measurement either, and does not use its deviation for the fiber drawing process control. It has been for a long time search process of PTO, more than 2 years.

The Examiner expresses: He appreciates Applicant to refer that to the MPEP. That relates to the 112 issue. He doesn't think they have an issue for that. He drafted the claim and didn't want to introduce any new matter. There will be no 112 issues. He says: “We can really move beyond that. The question is how broad you want to try to make the claim, whether or not define the prior art when you do that.”

Applicant expresses: "We both go to the point. First, we recognize that this is a patentable material there. Another thing is that MPEP 2173.02 mentions that when the material is there, it is allowable." The last O.A. has only issue of 112. He further expresses there is no new issues. No prior art teaches or suggests that. The claimed present invention is definitely unobvious, new, novel, useful and patentable.

The SPE points out that what the Examiner tries to say is: the amendment Applicant submitted makes amendments on the proposed amendments, but they brought out what he indicated is allowable. They are going to search the prior art to look for those. "We are not to argue to have prior art or no prior art right now. When we do our Office Action, we will look for the prior art. It could bring some prior art you haven't seen before."

2. Claims 21-22 and 24-25: Applicant points out that the last O.A. has only rejection on the 112 for two terms: (a) "based on" and (b) "robust". For the term "based on", the rejection has been removed by the SPE and the Examiner. Applicant appreciates that. (b) Another is for the term "robust". Also, the last O.A. does not list "robust control" for rejection. Applicant expresses that the term "robust control" is an established term, a technical term. He doesn't need to define this term, like "control". But many control methods, many things for process methods need to be developed. Applicant does that way. Applicant also finds the Examiner is also reasonable to allow people to use the "robust" in claim, patent 6895782. People use the word "robust" in claim, but in the specifications have no mention for the word "robust".

The SPE points out that they already resolved this issue. He thinks, they already move pass that one.

Applicant thanks for that term passed. He expresses that he agree with the SPE, and last time the SPE agreed with Applicant and allowed him to make these changes. He deleted "robust performance" to show his co-operation to work together.

3. Claim 26: regards to the double measurements of the bare fiber. Applicant expresses that the word "double" is summarized and recognized by Examiner Peter Chin during the interview. The O.A. rejection is only on the 112, the 1st paragraph to that, and the 2nd paragraph to the terms "robust" and "based on". Applicant says that

the word “double” is fully supported by all the figures and the Specification with the equivalent word “twice”. On 4-27-2006, the SPE also agreed with that. Thus, Claim 26 should be allowed now.

V. Brief identification of the general thrust of the principal arguments presented to the Examiner:

Please see the above mentioned. In addition, the followings are presented and discussed:

1. Applicant expresses that: It all has been searched for more than 2 years. If having the prior art with that, it definitely can not be patented. But it is not the fact. The fact is that no prior art suggests use of the preform diameter measurement for the fiber drawing process control, or its deviation for the fiber drawing process control, etc.
2. Applicant asks questions: where can you find any prior art to say the disclosures and to have motivation? Also, the previous Examiner suggested combinations of the references are inoperable!
3. Applicant points out that for a rejection (non-112), all claim limitations must be taught or suggested by the prior art. Please see the court decisions and MPEP 2143.
4. Applicant points out that in the Specification he compares it with the prior art, and the present invention is novel, unobvious, useful and thus patentable. He respectfully requests the consideration.
5. The Examiner expresses: he understands that. Applicant expresses his thanks.
6. Applicant respectfully requests to consider evidence of secondary considerations:
 - Professional Recognition – The present invention was given an award and recognition by the University of North Carolina at Charlotte (UNCC);
 - Competitive Recognition – Some foreign (non-China) company filed a patent application in China, the content of that is basically similar and close to this present invention as they recognized and checked with the Applicant’s China patent application, that follows the US PTO permission notice of an international patent application for the present invention.
 - Some Foreign Company Intended to Purchase the Present Invention Application.

The Examiner says: “The question is what the patent examiner in the United States thinks after doing a prior art search and total analysis of the case. We don’t rely on

any could happen in other countries when we make determination.”

Applicant reminds MPEP 716.03.II. COMMERCIAL SUCCESS ABROAD IS RELEVANT, and expresses that there may have some potential success in future as the submitted letter with the stamp and people’s sign from a company.

The Examiner expresses that he always consider secondary considerations, but they may not be convinced.

Applicant points out that the above mentioned secondary considerations successes are related to his patentable materials and they are convinced evidences. He respectfully requests to consider that.

The Examiner expresses that he understands.

The SPE explains what commercial success needs, He also says: “That’s maybe further down to the road. You may not even need that at this point. ...”

7. Applicant mentions that Examiner Peter Chin, who interviewed Applicant in March 2005, summarized Applicant’s statements, looked at Applicant’s presented summarized diagrams and table. He is reasonable and recognizes that.
8. Applicant mentions that last time Applicant talked with the SPE. He thinks, the SPE is also reasonable. Both sides are reasonable. At that time, the SPE agreed with Applicant’s doing changes reasonably and supported by the Specification. But he mentioned that Applicant could not separate the allowable claim into two parts. Applicant took the SPE’s suggestion. Then at that time, Applicant pointed out where the changes are supported by the Specification and so on. Both sides were agreeable.
9. Applicant expresses that the Specification does compare the present invention with the prior art. The present invention is novel, unobvious and useful, so is patentable.

VI. General indication of any other pertinent matters discussed:

1. Applicant expresses his un-satisfaction that he does not understand why to go for a new search from the beginning, because no new matter is there, all last O.A. rejections are issues of 112, he has addressed all these issues, the Examiner says no 112 issue now, and it has been searched for more than 2 years. Thus, Applicant thinks, it is unreasonable to start a new search now, though he agrees with waiting for the new search.

Applicant further expresses that he does not want any mistake Office Action. He requests a discussion before the O.A. to avoid any mistake and error in the O.A., because the Examiner can see the previous history of all the O.As with many errors there, which distort the references Applicant wants both to work together and to speed up. He expresses that all these claims are in the proper form and define patentably over the prior art.

The Examiner says: "I understand you frustrated with what has happened." He states that he will do his best and a free O.A. He further expresses that since he just takes up this case, he does not have benefit of a lot of background, he takes the responsibility and wants to do search his own.

Applicant requests that after the search the Examiner will make reasonable and correct conclusion. Applicant expresses his view point that the present invention is patentable over the prior art.

2. The Examiner mentions that he has until July 15 or 14 to prepare the Office Action. Applicant does not have to submit any fees for response to this Office Action. If both sides can work out at that point, that is easy way to proceed towards allowance.
3. The SPE expresses that as the Examiner says, if any proposal, the Examiner definitely can tell Applicant because there are both sides' best interests. He says: "We move the case along and get it out my office as quickly as possible."

Applicant appreciates that.

4. The SPE expresses no decision now before the search.

Applicant expresses that it is not correct to have a decision and then to search for this decision, in view of the history.

5. Applicant respectfully requests any constructive suggestions.

The Examiner says: when he writes the next communication, he will not only go through what he perceived to be the problems of the claims, but also provide suggestions for how to make the claims allowable.

6. Applicant asks: could give him a call after the new search before the next O.A. to have a brief discussion and to be able to work together?

The Examiner expresses that if he has any question, he will give the Applicant a call.

He wants all issues to be written down. He says: there is other issue, if the claims are allowable, then next thing you will see from me a notice for allowance.

7. As to "historical" measurement data, Applicant has deleted that claim in view of the Examiner's proposed allowable claim and because Applicant does not want to add something on that allowable claim. Applicant shows work together and to speed up.
8. Applicant asks: When he should submit this Record, before the Examiner's Summary or after the Summary?
The Examiner answers: "Any time."
9. Applicant respectfully requests the PTO to view and recognize the new, useful, unobvious and patentable merit of the present invention as whole.
10. Applicant states that he very appreciates the Honorable Under Secretary to visit the UNCC to promote the President's ACI (American Competitiveness Initiative). Again, Applicant expresses his thanks to the Honorable Under Secretary and the Honorable Commissioner for Patents for their very helpful advices.

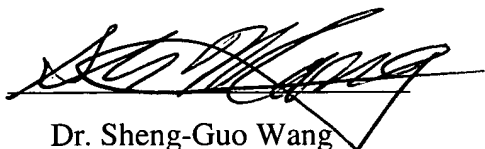
VII. General results or outcome of the interview:

There will be no issues of 35 US 112 in the O.A. The examiner agrees with the correction on the Examiner's proposed allowable claim for "drawing said optical fiber from said preform at a drawing speed ...". Thus, Claim 39 has been allowed by the Examiner.

Applicant is informed that the Examiner needs and starts a new search, and is working on the deadline (mid-July), and mail it by a certain day. Applicant had to wait for the new search and the next O.A.

Applicant clearly states that the claimed present invention is patentable over the all prior art, the claims all define patentably over the prior art, and are in proper form, and he respectfully requests a timely Notice of Allowance be issued in this case.

Respectfully submitted by the applicant



Dr. Sheng-Guo Wang

704-503-0747